

REMARKS

Upon entry of the present Amendment-A, the claims in the application are claims 1-22, of which claims 1, 11 and 22 are independent. Claims 1, 2, 8 and 11-18 have been amended. New claims 21 and 22 have been added.

The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment-A is submitted. Applicant respectfully submits that all of the above amendments are fully supported by the original application. Applicant also respectfully submits that the above amendments do not introduce any new matter into the application. It is contended that by the present amendment, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claim rejections – 35 USC § 103

In the Office Action, claims 1-4 and 6-20 are rejected under 35 USC § 103 (a) as being unpatentable over Kim (5,429,285) in view of Bowen (2,699,865); and claim 5 is rejected under 35 USC § 103 (a) as being unpatentable over Kim and Bowen, and in further in view of Garber, Jr. (5,316,178).

In his rejection, the Examiner states that Kim discloses an apparatus 30, for holding and storing tools used in a vehicle, comprising a storage body 30, shaped to fit securely in a hub of a spare wheel, where the storage body is an integral, unitary member, and where the tool-storage spaces are formed as recesses in the body; and Kim also teaches forming a plurality of depressions of suitable shapes on the bottom of the lower part 30, for keeping hand tools in place.

Further, in his rejection, the Examiner states that Bowen teaches a tool kit that has specifically-shaped recess to secure particular tools as well as a storage well 15 for storing other tools and/or accessories; and Bowen's device provides jack storage spaces 16, 18, and a storage well 32 on opposite sides of a lug wrench-receiving space 20. The Examiner asserted that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Kim by resizing and reshaping the tool-retaining recesses (also auto-related tool retaining recesses) and to include a separate storage well or plurality of wells, as taught by Bowen, in order to store additional items.

Applicant disagrees with, and traverses this ground of rejection.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis, with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is

patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The Federal Circuit has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Applicant respectfully suggests that the Examiner may be evaluating applicant's invention using improper hindsight, picking and choosing selected portions of the references and combining those selected portions to reconstruct a mosaic of applicant's invention. Applicant respectfully suggests that such an approach is not consistent with the standards set out in the above-quoted cases of the CAFC.

Applicant respectfully submits that even if the cited references are hypothetically combined, for the sake of argument, the combination fails to produce applicant's claimed invention for several reasons.

For example, Kim discloses a receptacle having a bowl 10 and a 2-part cap 40 detachable from the bowl. The cap and bowl are fitted inside a rim 51 of a spare wheel 50 placed on a bottom

54 of a compartment of a car trunk. To facilitate opening/closing of the bowl using the cap, an internal thread 6 is formed on a portion adjacent to upper extreme of the bowl, and an external thread 32, adapted to engage with the internal thread 6, is formed on an outer periphery of the cap 40.

Further, Kim discloses that the cap is divided into a lower part 30, shaped to form a tray with predetermined (shallow) depth, and an upper part 20 for detachably covering the lower part. The lower part 30 is formed with a plurality of depressions 34 of suitable shape on a bottom portion thereof for keeping hand tools. The upper part 20 has a depression 23 formed on top thereof for snugly embedding a sign indicating a car is in trouble on road (col. 2, lines 7-38, Fig. 1).

Kim also discloses that the receptacle, e.g., a portion of the receptacle below the cap, can be used as a container for storing various objects (duster, containers for lubricant or antifreeze, etc.), a reservoir for containing liquid, e.g., lubricant when refilling the antifreeze, a toolbox and a potable traffic sign (col. 3, lines 31-38).

Thus, the receptacle of Kim is divided into three portions, a first cap portion for storing the sign, a second cap portion formed as a tray for storing hand tools therein, and a third (bowl) portion below the cap to be used as a container. Such a divided receptacle, fitted within a hub of a spare wheel, fails to provide enough storage space for storing a jack and a lug wrench therein, as required by claims 1 and 11. A jack and a lug wrench are comparatively larger in size than the hand tools for which the storage tray of Kim is provided. Also, Kim fails to suggest modifying his receptacle for storing a jack and a lug wrench therein.

Further, in using Kim's apparatus, in order to access hand tools stored within the cap (the second part), a bolt 42, used for assembling the upper part 20 and lower part 30 together, needs to

be unscrewed, and therefore, any difficulty experienced in unscrewing the bolt 12 may jeopardize access to hand tools. Kim also fails to disclose any easily accessible tools and/or storage space needed for a tool to operate the bolt 42, which is normally disposed above the concealed tool storage tray.

Furthermore, in using Kim's apparatus, in order to access contents of the third portion, the cap threaded to an internal periphery on an upper extreme of the bowl needs to be opened. Thus, the cap is disadvantageous because opening the cap may be hindered if the threads on the cap and/or on the bowl are damaged, corroded or broken.

Still further, Kim discloses that the bowl 10 is fitted inside the rim 51 of the spare wheel 50 with a spare wheel installer 14 which guides the bolt 12 interposed between the bowl 10 and the rim 51, and fixed by means of the bolt 12; and it is preferable to form the installer 14 integral with the bottom of the bowl 10 to prevent the installer 14 from being lost (Figs. 2, 4 and 5). Thus, when the spare wheel is required to be installed in place of a flat or otherwise damaged wheel, the bowl needs to be separated from the rim of the spare wheel requiring tools to operate the bolt 12, and any difficulty in unbolting the bolt 12, for separating the bowl from the spare wheel, may jeopardize the object of installing the spare wheel quickly and easily.

On the contrary, in the claimed invention, a vehicle-raising jack and a lug wrench are readily accessible because they are not covered with a cap which is bolted in place. The tire-changing tools according to the invention are securely disposed in the respective receiving spaces formed in the storage body, which is shaped and dimensioned to fit within a spare wheel of the vehicle. Also, one or more user selected accessories stored in a hollow storage well of the claimed apparatus are readily accessible as the apparatus does not have a fastened-in-place cover or a similar structure.

In case of emergency, such as an urgent roadside situation needing a change of wheel (for example, flat tire) of a vehicle, the claimed invention is advantageous over Kim's apparatus because the claimed invention provides a simple, easy-to-use and reliable apparatus for changing a wheel. In severe weather conditions such rain, snow, very cold conditions including winter storms, it is desired to change a wheel as quickly as possible in a minimum amount of time to avoid the adverse effects of severe weather on a person changing the wheel.

When changing a wheel, a user of the claimed invention simply needs to take out a single integrated package from the vehicle, the package consisting of the spare wheel with the storage body including a jack and a lug wrench stored therein. The user is then able to remove the storage body from the spare wheel and place it on the ground, place the jack for raising an affected wheel, remove the affected wheel from a driving arrangement of the vehicle by unbolting lug nuts using the lug wrench, and the user can temporarily store the removed lug nuts in a storage well formed in the storage body. The user is then able to mount the spare wheel on the driving arrangement by bolting the stored lug nuts from the storage well onto the lug bolts, dispose the storage body within a rim of the affected wheel, remove the jack, and store the jack and the lug wrench at their respective spaces in the storage body. Thus, all the accessories for changing a wheel are readily accessible, and the lug nuts temporarily stored in the storage well, are never misplaced.

Whereas, using Kim's apparatus for changing a flat tire or damaged wheel may disadvantageously require searching for a jack and a lug wrench in the automobile, as they are not stored within the spare wheel. Further, Kim fails to disclose readily available space for temporarily storing the lug nuts, while changing the wheel. In Kim's apparatus, accessing tools stored in the lower cap requires removing the cap by unthreading the nut which holds the cap to

the bowl, and if the threads of either bowl and/or cap are damaged, it may cause problem in opening the cap, and hinder access to required tools.

Thus, the claimed invention is simple, reliable and advantageous over the disclosure of Kim for replacing the wheel.

Further, we note that Bowen discloses a portable tool container, formed of molded paper pulp, composed of bottom 12 and top 14 hinged along a edge 22 by a fold in pulp 23 molded therein with a fastener 24 on opposite side of edge 26, the bottom and top each having corresponding cavities for a bumper jack 16, a jack base 18, a jack handle 20, and other assorted tools. Also, Bowen's tool kit includes a very large cavity for a long, old-fashioned type of bumper jack.

However, Bowen neither suggests nor discloses that his tool kit can be fitted within a spare wheel of a vehicle. Rather, he suggests providing an elongated container that is easily portable and inherently balanced when carried in one hand. This teaches away from the claimed invention, in which, a storage body is shaped and dimensioned to fit within a spare wheel of the vehicle.

Also, since Bowen does not disclose or suggest a tool kit that is shaped and dimensioned to fit with cylindrical portion of a wheel of vehicle, combining Bowen's tool kit with Kim's receptacle would not achieve the claimed invention.

Still further, the claimed invention provides the storage well having a large volume in a tight space in a vehicle. Such large volume as large as or larger than the jack storage space, and much larger than lug wrench and jack receiving grooves, allows for relatively large, variable use storage area in a tight space in a vehicle, i.e., in the hub of the spare wheel, is patentably distinct over both the references, either considered singly or in combination, as recited in claim 1 and 11.

Applicant respectfully disagrees with the Examiner's rejection of claims 2-4, 6-10 and 12-20 for the reasons provided in relation to claims 1 and 11, hereinabove.

Applicant also respectfully disagrees with the Examiner's rejection of claim 5 for the reasons given above in relation to claims 1 and 11, hereinabove, which are not overcome by additional teachings of Garber, Jr. Also, Garber's inventions relates to a fruit-ripening ethylene gas storage and dispensing system and container, which is non-analogous art to the claimed invention.

Applicant also respectfully submits that the claimed invention is patentably distinct over Honda's own prior art (Fig. 5 of the present application) because, although the previously known foam block storage apparatus has a large recess formed in central portion thereof which is shaped to receive and store a scissors-type vehicle raising jack, and a pair of shallow recesses formed on opposite sides of the central recess and shaped to securely receiving a lug wrench and a jack bar therein, the block is limited to storage of the jack, the lug wrench and the jack bar, and fails to provide a suitable storage space for temporarily storing lug nuts during a tire-changing operation. Further, the storage apparatus of Fig. 5 does not include or suggest the other limitations of the claims, as presently amended.

Applicant therefore requests reconsideration and withdrawal of the Examiner's rejection of claims 1-20 under 35 USC § 103(a).

Other Matters

In the interest of expediting prosecution of the application, applicant has amended claims 1, 2, 8 and 11-18 by the present amendment. New claims 21 and 22 have been added to define additional aspects of the present invention.

Claim 1 has been amended to specify that a top surface of the storage body defines a substantially flat plane, said top surface including edges and medial portions of the storage body; and wherein upper tool surfaces are equal with or below the flat plane in a stored configuration of said tools. This limitation is not taught, suggested nor rendered obvious by the references of record, and is completely different from the teaching of Kim and Bowen.

Claim 2 has been amended to specify that the storage body is configured and dimensioned with a sufficient depth to allow the jack storage space to nestingly receive a scissors jack or a hydraulic bottle-type jack therein, in a compact configuration of the jack; and wherein the jack storage space extends from a side edge of the storage body to an opposite side edge thereof. The total combination of claim is not taught, suggested nor rendered obvious by the references of record.

Claims 8 and 11 have been amended to specify that wherein said jack storage space extends from one side edge of the storage body to an opposite side edge thereof. The total combination of each of claims 8 and 11 is not taught, suggested nor rendered obvious by the references of record.

Claim 12 has been amended to specify that the storage body is configured and dimensioned with a sufficient depth to allow the jack storage space to nestingly receive a scissors jack or a hydraulic bottle-type jack therein, in a compact configuration of the jack. The total combination of claim 12 is not taught, suggested nor rendered obvious by the references of record.

Claims 13-18 have been amended to correct typographical errors.

In the specification, paragraphs [028] and [032] have been amended to further clarify the subject matter of the present application.

Applicant respectfully submits that the above amendments and new claims are fully supported by the original disclosure including drawings, and that no new matter is introduced into the application by amending the claims and specification.

Conclusion

Based on all of the foregoing, applicant respectfully submits that all of the objections and rejections set forth in the Office Action are overcome, and that as presently amended, all of the pending claims are believed to be allowable over all of the references of record, whether considered singly or in combination. Applicant requests reconsideration and withdrawal of the rejection of record, and allowance of the pending claims.

Applicant sent an informal draft of proposed claim amendments to Examiner Larson via fax on 21 September 2005, and telephoned the Examiner to request review of same. Subsequently, a telephone interview was held on 5 October 2005, to discuss the proposed claim amendments. During the interview, Examiner Larson and Primary Examiner Nathan Newhouse indicated that they had reviewed the draft of claim amendments, and that pending further review, they felt that the limitations contained in the enclosed draft amendment should patentably distinguish over the art. Applicant thanks the Examiners for reviewing the draft amendment, and for the courtesy extended in this telephone interview.

If any issues remain unresolved, applicant respectfully requests that the Examiner telephonically contact applicant's undersigned representative to expeditiously resolve prosecution of the application.


The Commissioner is hereby authorized to charge \$100.00 for two additional claim (total 22 claims) in excess of 20, as well as to charge any deficiency which may be required during the entire pendency of the application, and to credit any excess paid during the entire pendency of the application, to Deposit Account 50-0744 in the name of Carrier, Blackman & Associates, P.C.

A duplicate copy of this sheet is enclosed.

Favorable consideration is respectfully requested.

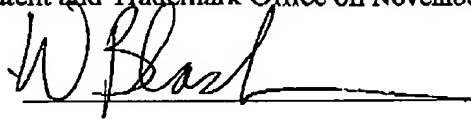
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted, via facsimile, to Examining Group 3727 of the United States Patent and Trademark Office on November 7, 2005, at the number (517) 273-8300.



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